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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,568	06/25/2003	Daniel S. Choi	217 P 922	3360

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EXAMINER

CHOI, JACOB Y

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,568

Applicant(s)

CHOI ET AL.

Examiner

Jacob Y. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/7/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/25/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/04, 12, 11, 9/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-7, 10-15, 19, 20, 22, 23, 27 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-14, 16-20 and 22-28 of U.S. Patent No. 6,851,820.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 1, 3, 5, 6, 7, 10, 11, 12, 15, 20, 22, 23, 27 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,851,820. Claims 11-14, 16-20 and 22-28 of U.S. Patent No. 6,851,820 recite a light for a barbecue grill where the conflicting claims does not identically recite the terms; a first pod and a second pod. However, otherwise

recites a light housing having first and second housing member, which are equivalent terms and holds the same patentable meaning.

Claims 2, 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 18, 22 of Patent No. 6,851,820.

Claim 13 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16, 20, 23 and 27 of Patent No. 6,851,820.

Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27 and 28 of Patent No. 6,851,820.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 6, 7, 8, 10, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055).

Regarding claims 1, 6, 7 and 8, Shoji disclose a fixture having a first mating member, the fixture being fabricated to be secured to the handle, a removable first pod having an illumination device and a second mating member, the second mating member of the first pod removably engaging the first mating member of the fixture to removably

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secure the first pod to the fixture. Shoji discloses the claimed invention, except for the housing has a first connector to secure the housing to a barbecue grill. However, reference Shoji suggests that the illumination device may be removably attached to the handle or the like of a bicycle (column 3, line 9). Grisamore et al. teaches a barbecue light where the handle (21) itself is a light-containing tube that provides lighting for the barbecue grill, which shows motivation of need to illuminate cooking surface of the barbecue grill. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize apparatus of Shoji onto the barbecue grill lid handle of Grisamore et al. to illuminate the cooking area.

Regarding claim 10, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. In addition, Shoji discloses the first mating member depending from the fixture is one of a male protrusion or a female receiver, and wherein the second mating member depending from the pod is the other of the male protrusion or female receiver.

Regarding claim 11, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. In addition, Shoji discloses the male protrusion and the female receiver mate in a frictional fit to secure the pod to the fixture.

Regarding claim 12, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. In addition, Shoji discloses one of the male protrusions and the female receiver has a stop to position the pod on the fixture.

4. Claims 2, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055) as applied to claim 1 above, and further in view of Petzl et al. (USPN 6,499,859).

Regarding claims 2, 9, and 13, Shoji in view of Grisamore et al. discloses the claimed invention, explained above. Shoji lacks specific teachings of a manual switch, however drawing figures of Shoji (Figure 1) clearly shows a manual switch electrically connected to the internal power source to control illumination of the device. Also, Petzl et al. teaches the common manual switch that is utilized for a portable lighting lamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify teachings of Shoji with Petzl et al. to include a switch member to operate the lighting means under user's control.

5. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Grisamore et al. (USPN 6,132,055) as applied to claim 1 above, and further in view of Sutherland et al. (USPN 5,641,220).

Regarding claim 3, Shoji in view of Grisamore et al. discloses the claimed invention, except for an additional or second lighting device that is in connection with the first lighting device as described above. Sutherland et al. teaches multiple or two lighting device that is in connection with the first light device (Figure 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide additional or second housing member in connection with the first lighting device as taught by Southerland et al. to provide even great illumination in varying positions. In

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addition, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 4, Shoji in view of Grisamore et al. and Sutherland et al. discloses the claimed invention, explained above. In addition, Sutherland et al. discloses the first pod has a first internal power source and a first switch to independently manipulate illumination of the illumination device of the first pod, and wherein the second pod has a second internal power source and a second switch to independently manipulate illumination of the illumination device of the second pod.

Regarding claim 5, Shoji in view of Grisamore et al. and Sutherland et al. discloses the claimed invention, explained above. In addition, Sutherland et al. discloses the fixture has a handle portion (handle bar) between the first pod and the second pod.

6. Claims 15, 16, 17, 18, 21, 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Petzl et al. (USPN 6,499,859).

Regarding claim 15, Shoji discloses a housing (Figure 1) having a first mating member (11), a removable first pod (1) having an illumination device and a second mating member (13), the second mating member of the first pod removably connecting the first mating member of the housing to removably secure the first pod to the housing, the first pod having an independent internal power source (3) located within the first pod

for illuminating the illumination device of the first pod (1). Shoji lacks specific teachings of a manual switch, however drawing figures of Shoji (Figure 1) clearly shows a manual switch electrically connected to the internal power source to control illumination of the device. Also, Petzl et al. teaches the common manual switch that is utilized for a portable lighting lamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify teachings of Shoji with Petzl et al. to include a switch member to operate the lighting means under user's control.

Regarding claim 16, Shoji in view of Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses the second mating member of the first pod slidingly engages (14) the first mating member of the housing to removably connect the first pod to the housing.

Regarding claims 17 & 21, Shoji in view of Petzl et al. discloses the claimed invention, explained above. In addition, Petzl et al. discloses the illumination device comprises a plurality of light emitting diodes (16).

Regarding claim 18, Shoji in view of Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses the light bulb of the illumination device utilizes reflector and lens member to directionally focus in varying positions.

Regarding claim 22, Shoji in view of Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses the first mating member removably engages the second mating member without hardware.

Regarding claim 25, Shoji in view of Petzl et al. discloses the claimed invention, explained above. In addition, Shoji discloses an extension depends from the housing, and wherein the extension has a first connector to secure the extension to a surface.

7. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Petzl et al. (USPN 6,499,859) as applied to claim 15 above, and further in view of Sutherland et al. (USPN 5,641,220).

Regarding claim 19, Shoji in view of Petzl et al. discloses the claimed invention, except for an additional or second lighting device that is in connection with the first lighting device as described above. Sutherland et al. teaches multiple or two lighting device that is in connection with the first light device (Figure 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide additional or second housing member in connection with the first to provide even great illumination in varying positions. In addition, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 20, Shoji in view of Petzl et al. and in further in view of Sutherland et al. disclose the claimed invention, explained above. In addition, Shoji discloses housing has a handle portion (column 3, line 9) for grasping by the user, the handle portion located between the first pod and the second pod when first and second pods are removably secured to the housing.

8. Claims 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Petzl et al. (USPN 6,499,859) as applied to claim 15 above, and further in view of Grisamore et al. (USPN 6,132,055).

Regarding claims 23 & 26, Shoji in view of Petzl et al. disclose the claimed invention, except for the housing has a first connector to secure the housing to a barbecue grill. However, reference Shoji suggests that the illumination device may be removably attached to the handle or the like of a bicycle (column 3, line 9). Grisamore et al. teaches a barbecue light where the handle (21) itself is a light-containing tube that provides lighting for the barbecue grill, which shows motivation of need to illuminate cooking surface of the barbecue grill. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize apparatus of Shoji onto the barbecue grill lid handle of Grisamore et al. to illuminate the cooking area.

9. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Petzl et al. (USPN 6,499,859) and further in view of Sutherland et al. (USPN 5,641,220).

Regarding claim 27, Shoji discloses a housing (Figure 1) having a first mating member (11), a removable first pod (1) having an illumination device and a second mating member (13), the second mating member of the first pod removably connecting the first mating member of the housing to removably secure the first pod to the housing, the first pod having an independent internal power source (3) located within the first pod for illuminating the illumination device of the first pod (1). Shoji lacks specific teachings

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of a manual switch; however drawing figures of Shoji (Figure 1) clearly shows a manual switch electrically connected to the internal power source to control illumination of the device. Also, Petzl et al. teaches the common manual switch that is utilized for a portable lighting lamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify teachings of Shoji with Petzl et al. to include a switch member to operate the lighting means under user's control.

Shoji in view of Petzl et al. discloses the claimed invention, except for an additional or second lighting device that is in connection with the first lighting device as described above. Sutherland et al. teaches multiple or two lighting device that is in connection with the first light device (Figure 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide additional or second housing member in connection with the first to provide even great illumination in varying positions. In addition, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 28, Shoji in view of Petzl et al. and further in view of Sutherland et al. discloses the claimed invention, explained above. In addition, Sutherland discloses the second mating members of the first and second pods slidably engage the respective first mating members of the housing to independently removably connect the first and second pods to the housing.

Regarding claim 29, Shoji in view of Petzl et al. and further in view of Sutherland et al. discloses the claimed invention, explained above. In addition, Petzl et al.

discloses the illumination devices of the first and second pods comprises a plurality of light emitting diodes.

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji (USPN 5,378,553) in view of Petzl et al. (USPN 6,499,859) and Sutherland et al. (USPN 5,641,220) as applied to claim 27 above, and further in view of Grisamore et al. (USPN 6,132,055).

Regarding claim 30, Shoji in view of Petzl et al. and Sutherland et al. disclose the claimed invention, except for the housing has a first connector to secure the housing to a barbecue grill. However, reference Shoji suggests that the illumination device may be removably attached to the handle or the like of a bicycle (column 3, line 9). Grisamore et al. teaches a barbecue light where the handle (21) itself is a light-containing tube that provides lighting for the barbecue grill, which shows motivation of need to illuminate cooking surface of the barbecue grill. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize apparatus of Shoji onto the barbeque grill lid handle of Grisamore et al. to illuminate the cooking area.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Taylor et al. (USPN 6,283,620) – light for an individual engaged in a sport activity

Taylor et al. (USPN 6,264,351) – convertible orientation bicycle lamp

Maglica (USPN 5,860,728) – holder clamp assembly

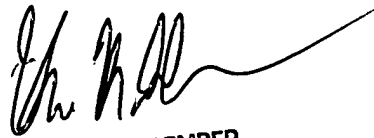
Sun et al. (USPN 5,477,425) – bicycle lamp device

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC



THOMAS M. SEMBER
PRIMARY EXAMINER